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**JUN 07 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Mltchell, et al.	:	DECISION
Application No.: 10/614,940	:	
Filing Date: 7 July, 2003	:	
Attorney Docket No. 590-004	:	

This is a decision on the petition filed on 24 April, 2006, to revive the instant application under 37 C.F.R. §1.137(b) as having as abandoned due to unintentional delay, and also seeks relief under the provisions of 37 C.F.R. §1.181, §1.182 and §1.183 .

For the reasons set forth below the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**; and the petitions as considered under 37 C.F.R. §1.181, §1.182 and §1.183 are **DISMISSED**.

**It appears that, as of 7 March, 2005, Petitioner no longer was empowered to prosecute the instant application. If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.**

**Further, all parties, including Petitioners, always are reminded of the burden of those registered to practice *and* all others who make representations before the Office, *inter alia*, to inquire into the underlying facts of representations made to the Office.**<sup>1</sup>

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under 37 C.F.R. §1.137(b).”

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<sup>1</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

**§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.**

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party’s own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party’s knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner’s designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

- (2) Thereafter, there will be no further reconsideration of this matter.

### BACKGROUND

The record reflects that:

- after a change of Power of Attorney in March 2005, from Kristofer Halvorson (Reg. No. 39,211) (Mr. Halvorson) to David A. Gass (Reg. No. 38,153) (Mr. Gass) the Assignee–Phlo System Inc. (PSI) by and through James B. Hovis (Mr. Hovis), representing to the Office that he is President of said Assignee–representing to the Office that it held 100 percent of the interest in the instant application (and upon presenting to the Office a copy of the Assignment) sought on 26 January, 2006, an Express Abandonment, which was granted on 6 February, 2006, and the abandonment was effective that date;<sup>2</sup>
- the application has remained abandoned thereafter;
- on 24 April, 2006, Petitioner Mr. Halvorson filed the instant petition representing a lack of authority by PSI and/or Mr. Hovis to seek and obtain an express abandonment, and alleging therein other matters not of record;
- clearly there at the very least an incongruity in the representations made by Petitioner herein, which are, as are all representations by practitioners and applicants before the Office, susceptible to review for compliance with the duty of candor.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

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<sup>2</sup> The commentary at MPEP §711.01 states in pertinent part:

#### **711.01 Express or Formal Abandonment [R-3] - 700 Examination of Applications**

#### **711.01 Express or Formal Abandonment [R-3]**

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment. (Emphasis supplied.)

\* \* \*

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>3</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>4</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>5</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>6</sup> And the Petitioner must be diligent in attending to the matter.<sup>7</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>8</sup>))

#### Allegations as to Unintentional Delay

The regulatory requirements of a petition under 37 C.F.R. §1.137(b) are the petition, fee, reply, statement/showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

As of this writing Petitioner has not satisfied at least the statement/showing requirement.

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<sup>3</sup> 35 U.S.C. §133 provides:  
**35 U.S.C. §133 Time for prosecuting application.**  
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>4</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>5</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>6</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>7</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office* supra.

<sup>8</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

As to Relief Under 37 C.F.R.  
§1.181, §1.182 and §1.183

Petitioner has referred to documents not in evidence.

Petitioner has referred to proceedings not of record.

The provisions of 37 C.F.R. §1.181, §1.182 and §1.183,<sup>9</sup> respectively, seek intervention by the Director, address remedies not otherwise provided and seek waiver of the rules in the interest of justice.

Yet, Petitioner presents nothing more than two declarations, self-serving or otherwise, and provides no official documentation in support of, for example, the petition under 37 C.F.R. §1.181, and there is sufficient authority for revival in extent rules to obviate a pleading under 37 C.F.R. §1.182. As indicated earlier, Petitioner has made no official documentary showing that might support a waiver of rules in the interest of justice under 37 C.F.R. §1.183.

Petitioner's failure to act in compliance with statute(s) and regulation(s) creates no "extraordinary situation" requiring the invocation of the interests of justice. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay.<sup>10</sup> Moreover, the Office has no authority to waive the statutory requirements. Thus, Petitioner seeks a waiver pursuant to 37 C.F.R. §1.183<sup>11</sup> that is neither justified nor permitted, and Petitioner has not paid the required fee.

Petitioner has offered no basis for any of the relief sought.

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<sup>9</sup> The regulations at 37 C.F.R. §1.183 provide, in pertinent part:  
**§1.183 Suspension of the Rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. \* \* \*

<sup>10</sup> See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the time period set forth in 37 C.F.R. 1.193(b). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of or failure to properly apply the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977).

<sup>11</sup> Delay resulting from the inadvertence or mistake of Petitioner does not warrant equitable tolling of the time period of 37 C.F.R. §1.193(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983); Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Even assuming *arguendo*, that clerical inadvertence or error caused or contributed to the delay in filing the Reply Brief, such is not a ground for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

CONCLUSION

Accordingly, the petition as considered under 37 C.F.R. §1.137(b) is **dismissed**; further, the petitions under 37 C.F.R. §1.181, §1.182, and §1.183 are **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:<sup>12</sup>

By mail: Commissioner for Patents<sup>13</sup>  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

cc:  
Kristofer Halvorson  
1757 E. Baseline Rd./Ste. 130  
Gilbert AZ 85233

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<sup>12</sup> On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

<sup>13</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).